1645

CERTIFICATE OF MAILING
UNDER 37 CFR 1.8(a)

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Alexandria, VA 20231 on 21 June 2004

HUESCHEN AND SAGE

Kathleen L. Lindauer

Dated: 21 June 2004

* * * * *

Applicant	:	Toufic RENNO and Jean-Yves BONNEFOY
Serial No.	:	09/913,772
Filed	:	September 24, 2001
Title	:	USE OF AN ENTERBACTERIUM OmpA PROTEIN COMBINED WITH AN ANTIGEN, FOR GENERATING AN ANTIVIRAL, ANTIPARASITIC OR ANTITUMOR CYTOTOXIC RESPONSE
Art Unit	:	1645
Examiner	:	Robert A. ZEMAN, Esq.

* * * * *

Honorable Commissioner of Patents and Trademarks

Alexandria, VA 22313

RESPONSE AND AMENDMENT UNDER 37 CFR § 1.111

Sir:

Responsive to the Office communucation dated May 27, 2004, the Applicants traverse the Office position that the claims, as currently amended, do not read on the elected invention. The Applicants take this opportunity to clarify the Office misconstruction.

* * * * *

The Applicants submit that the Response and Election filed March 11, 2004 is fully responsive to the Office Action, a Restriction Requirement, dated October 7, 2003. It is the position of the Office that the main invention (Group I) comprises the first recited **method,** methods of preparing compositions comprising OmpA. It is Applicants assertion that the Office has misinterpreted the subject matter of generic Claim 44 and that of Restriction Group I.

Moreover, the Office position is inconsistant with USPTO procedure. With the Restriction requirement the Office mistakenly defined original Claims 44-57 of elected Restriction Group I, as being drawn to a method of preparing compositions comprising OmpA. Clearly the claims do not set forth any active, positive steps required for a process of using OmpA for preparing a composition. The mere recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. § 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd. App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966). Therefore, the Office interpretation was not only mistaken, but unnecessarily prejudicial. In view of the cited case law, the Applicants respectfully submit that the Office conclusion that the instant invention is drawn to a method of preparing compositions comprising OmpA is in error.

The claims were originally drafted as European "use" claims, which stated the intended use of the OmpA protein, or a fragment thereof, in a pharmaceutical composition useful for generating or increasing a cytotoxic T response against an infectious agent or a tumor cell. MPEP § 2111.02 provides guidance on the interpretation of "purpose or intended use" in claim language. The MPEP instructs that the context of the entire claim should be considered before concluding that the intended use is a limitation. The MPEP instructs the Examiner to review the entirety of the record to gain an understanding of what the inventors actually invented and intended to encompass by the claim. It would appear that the Office has mistakenly relied on insignificant European "use" language and completely ignored the substance of the claim, namely: